

claims 19-22, 27, 38-41, 56, 58, and 59 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,809,265 to Blair et al. (hereinafter "the Blair patent");

claims 9, 11, 12, 14, 16, 17, 25, 26, 33-35, and 37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Blair patent in view of IBM Technical Disclosure Bulletin, Vol. 36, No. 09B, September 1993, by Jackson et al. (hereinafter "the Jackson Bulletin");

claims 10, 13, 15, and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Blair patent in view of the Jackson Bulletin, as applied to claim 9 above, and further in view of U.S. Patent No. 5,996,029 to Sugiyama et al. (hereinafter "the Sugiyama patent"); and

claim 57 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the Blair patent, as applied to claim 56 above, and further in view of the Jackson Bulletin.

### **35 U.S.C. § 102(e) Rejection**

The rejection of claims 19-22, 27, 38-41, 56, 58, and 59 under 35 U.S.C. § 102(e), as being anticipated by the Blair patent, is respectfully traversed based on the following.

In order for the Blair patent to anticipate a claim of the present application, the Blair patent must disclose every element of that claim. As the following arguments will show, the Blair patent does not meet this requirement.

### **Claims 19-22**

Claim 19 requires a machine readable medium on which is recorded a program for selecting a desired image forming apparatus from a plurality of image forming apparatuses connected to a network, wherein the program comprises a select step for selecting as an output destination one of the image forming apparatuses designated by a user; a judgment step for judging whether or not the image forming apparatus set at the select step is capable of carrying out printing; and a display step for displaying on a display installation locations of the image forming apparatuses which are capable of carrying out printing to serve as a substitute for the image forming apparatus set at the select step in case an

outcome of the judgment formed at the judgment step indicates that the image forming apparatus set at the select step is not capable of carrying out printing. The Blair patent does not disclose or suggest all of these features.

Column 5, lines 13-38 of the Blair describes a process wherein a user is allowed to select a default printer and a secondary printer "with a single click of the mouse", i.e., at the same time, such that a default print operation will be performed by the default printer, and the secondary printer will be available for use when needed. The statement in the Blair patent that "the user can take a print job from the default printer and put it in the queue for the secondary device if the default device is in use" is in reference to the Blair device's capability to allow a user to transfer a print job from the default printer to the secondary printer when the default printer is in use. However, the Blair patent does not disclose or suggest displaying the locations of image forming apparatuses which are capable of carrying out printing to serve as a substitute for a selected image forming apparatus set at a select step in case judgement formed at a judgment step indicates that the selected image forming apparatus is not capable of carrying out printing. Therefore, the Blair patent does not anticipate claim 19.

Claims 20, 21, and 22 depend from claim 19. Therefore, claims 20, 21, and 22 are not anticipated by the Blair patent.

### Claim 27

Claim 27 requires an image forming apparatus selecting method for selecting a desired image forming apparatus from a plurality of image forming apparatuses connected to a network system, wherein the method comprises a select step for setting as an output destination one of the image forming apparatuses selected by a user; a judgment step for forming a judgment as to whether or not the image forming apparatus set at the select step is capable of carrying out printing; and a display step for displaying on a display installation locations of the image forming apparatuses which are capable of carrying out printing to serve as a substitute for the image forming apparatus set at the select step in case an outcome of the judgment formed at the judgment step indicates that the image forming apparatus set at the select step is not capable of carrying out printing.

As stated above with reference to claim 19, the Blair patent discloses that a default printer and a secondary printer can be chosen by a user at the same time, and at a time of a print operation, if the default printer is in use, the user can transfer the print job from the default printer to the secondary printer. However, the Blair patent does not disclose or suggest a display step for displaying on a display installation locations of the image forming apparatuses which are capable of carrying out printing to serve as a substitute for the image forming apparatus set at the select step in case an outcome of a judgment formed at the judgment step indicates that the image forming apparatus set at the select step is not capable of carrying out printing. Therefore, the Blair patent does not anticipate claim 27.

**Claims 38-40**

Claim 38 requires a machine readable medium on which is recorded a program for a network system connecting a plurality of computers and a plurality of input-output apparatuses wherein the program comprises a user name displaying step for displaying as items of selection the names of users regularly using the network system; a user name selecting step for selecting one of the names displayed at the user name displaying step; an input-output apparatus displaying step for displaying as items of selection only the input-output apparatuses associated with one of the users with the name thereof selected at the user name selecting step; and an input-output apparatus selecting step for selecting as an input-output destination a desired one of the input-output apparatuses displayed at the input-output apparatus displaying step.

The Office Action states that the Blair patent teaches a user name displaying step at column 4, lines 54-67. A relevant portion of column 4, lines 54-67 of the Blair patent discloses that "a map 116 of an office building is displayed and the end user 113 can move a pointing device such as a mouse (not shown) around the map to display the names 117 (e.g. Foothill Sierra 2 Bridge) of wings 118 of the map 116." Accordingly, names of users regularly using the network system, as required by claim 38, are not displayed. Instead, the Blair patent discloses displaying the names of areas, or wings, of the maps. Thus, "Foothill Sierra 2 Bridge" is the name of the wing of the office building represented by the

map 116, and is not the name of a user regularly using the network, as required by claim 38.

Similarly, as the Blair patent does not disclose or suggest a user name displaying step for displaying as items of selection the names of users regularly using the network system, it also follows that the Blair patent also does not disclose a user name selecting step for selecting one of the names displayed at the user name displaying step.

Therefore, because the Blair patent does not disclose or suggest all of the requirements of claim 38, the Blair patent does not anticipate claim 38.

Claims 39 and 40 depend from claim 38. Therefore, as claim 38 is not anticipated by the Blair patent, claims 39 and 40 could not be anticipated by the Blair patent.

#### Claim 41

The requirements for claim 41 include a user name displaying step for displaying as items of selection the names of users regularly using the network system and a user name selecting step for selecting one of the names displayed at the user name displaying step. As stated previously in the argument for claim 38 over the Blair patent, the Blair patent discloses that the names of areas of a map can be displayed, however, the Blair patent fails to disclose or suggest displaying as items of selection the names of users regularly using the network system and selecting one of the names displayed at the user name displaying step. Therefore, claim 41 is not anticipated by the Blair patent.

#### Claim 56, 58, and 59

Claim 56 includes the requirement of a step for selecting a second printer automatically, from a plurality of printers connected to a network, as a substitute output apparatus in response to the determination that the first printer is not available. The Blair patent does not disclose this feature.

The Blair patent discloses that a user can establish virtual connections to two network printers at the same time, one as default, and one available for use whenever it is needed. Column 5, lines 35-37 of the Blair patent further states "the user can take a print job from the default printer and put it in the queue for the secondary device if the default device is in use." Thus, according to the Blair patent, a second printer is not automatically selected; instead, a user changes the assignment of the print job.

Therefore, the Blair patent does not disclose or suggest selecting a second printer automatically from a plurality of printers connected to a network, as a substitute output apparatus in response to the determination that the first printer is not available.

As the Blair patent fails to disclose all of the requirements of claim 56, claim 56 is not anticipated by the Blair patent.

Claims 58 and 59 depend from claim 56. As claim 56 is not anticipated by the Blair patent, claims 58 and 59 are not anticipated by the Blair patent.

Accordingly, it is respectfully requested that the rejection of claims 19-22, 27, 38-41, 56, 58, and 59 under 35 U.S.C. § 102(b), as being anticipated by the Blair patent, be reconsidered and withdrawn.

**35 U.S.C. § 103(a) Rejections**

I. **Claims 9, 11, 12, 14, 16, 17, 25, 26, 33-35, and 37**

The rejection of claims 9, 11, 12, 14, 16, 17, 25, 26, 33-35, and 37 under 35 U.S.C. § 103(a), as being unpatentable over the Blair patent in view of the Jackson Bulletin, is respectfully traversed based on the following.

**Claims 9, 11, 12, and 13**

The requirements for claim 9 include a first display step for classifying input-output apparatuses into a plurality of categories with different functions and displaying the

categories on a display as items to be selected, and a second display step for displaying on the display as items to be selected only the input-output apparatuses classified in a category selected by a user.

The Blair patent does not disclose classifying input-output apparatuses into a plurality of categories with different functions and displaying the categories on a display as items to be selected.

Despite the statement in the Office Action, the Jackson Bulletin also does not disclose or suggest classifying input-output apparatuses into a plurality of categories with different functions and displaying the categories on a display as items to be selected. A portion of the third paragraph of the Jackson Bulletin discloses the following:

“Provided is a mechanism to automate selection of nearest printers suitable to print a user’s object based on the criteria set forth by the user and/or attributes of the intended object. This consists of Presentation Service that presents a Graphical User Interface (GUI) to allow a user to specify selection criteria. A Scan Service that collects the attributes and format of the object to be printed. The user’s criteria and the characteristics of the object are passed to a Selector Service to further process and select the nearest printer.”

However, there is no disclosure of classifying input-output apparatuses into a plurality of categories with different functions and displaying the categories on a display as items to be selected. Further, contrary to the assertion in the Office Action, the Jackson Bulletin does not disclose or suggest that the “selection criteria” specified by the user are categories with different functions used to classify input-output apparatuses, and thus, it cannot be inferred that the “selection criteria” of the Jackson Bulletin are categories with different functions that are used to classify input-output apparatuses.

Therefore, both the Blair patent and the Jackson Bulletin fail to disclose or suggest classifying input-output apparatuses into a plurality of categories with different functions and displaying the categories on a display as items to be selected. As this feature is a

requirement of claim 9, and absent from both of the cited references, claim 9 could not be rendered obvious by any combination of the cited references.

Each of claims 11, 12, and 13 depend from claim 9. Therefore, as claim 9 is distinguished and nonobvious over any combination of the Blair patent and the Jackson Bulletin, so too are claims 11, 12, and 13.

**Claims 14, 16, and 17**

Claim 14 requires a machine readable medium on which is recorded a program for selecting a desired input-output apparatus from a plurality of input-output apparatuses connected to a network comprising a first display step for classifying the input-output apparatuses into a plurality of categories with different pieces of user identification information and for displaying on a display as items of selection the pieces of user identification information and a second display step for displaying on the display as items of selection only the input-output apparatuses in a category corresponding to a thus displayed user identification information which is selected by a user. These features are not disclosed or suggested by either of the Blair patent or the Jackson Bulletin. In fact, neither the Blair patent nor the Jackson Bulletin discloses or suggests the use of user identification information.

Although the Office Action does admit that the Blair patent does not teach the use of categories that are different pieces of user identification information, the Office Action states that the Jackson Bulletin "teaches to use a display (User Interface, line 17) for allowing users to enter different user identification information (code)(user specify selection criteria, line 18) and from the user identification information (user specify selection criteria, line 18), display available printers (line 17-31)." However, although the Jackson Bulletin does teach that a user can "specify selection criteria", the Jackson Bulletin does not disclose or suggest the use of user identification information, and even further, does not teach or suggest displaying as items of selection only the input-output apparatuses in a category corresponding to a thus displayed user identification information which is selected by a user.

Therefore, like the Blair patent, the Jackson Bulletin fails to disclose or suggest classifying input-output apparatuses into a plurality of categories with different pieces of user identification information and displaying on a display as items of selection the pieces of user identification information, and displaying on the display as items of selection only the input-output apparatuses in a category corresponding to a thus displayed user identification information which is selected by a user. Thus, claim 14 could not be rendered obvious by any combination of the Blair patent and the Jackson Bulletin.

Claims 16 and 17 depend from claim 14. Therefore, claims 16 and 17 could not be rendered obvious by any combination of the Blair patent and the Jackson Bulletin.

**Claim 25**

Claim 25 requires a method including a step for classifying input-output apparatuses connected to a network system into a plurality of categories with different functions and for displaying the categories on a display as items to be selected. The combination of the Blair patent and the Jackson Bulletin fails to disclose or suggest classifying input-output apparatuses connected to the network system into a plurality of categories with different functions and for displaying the categories on a display as items to be selected.

Although the Office Action correctly states that the Blair patent does not disclose classifying input-output apparatuses into categories with different functions, the Office Action states that the Jackson Bulletin does disclose this feature. However, the Jackson patent only states that a Graphical User Interface is used to allow a user to "specify selection criteria", and does not disclose or suggest that the selection criteria are categories with different functions into which the input-output apparatuses are classified.

Therefore, claim 25 recites an element that is neither disclosed nor suggested by the combination of the Blair patent and the Jackson Bulletin and thus, could not be rendered obvious by any combination of the two.

**Claim 26**

Neither the Blair patent nor the Jackson Bulletin disclose or suggest a step for displaying user identification codes on a display as items to be selected and a step for displaying on the display as items to be selected only the input-output apparatuses cataloged in one of the groups identified by one of the user identification codes selected by the user. As these elements are express requirements of claim 26, claim 26 could not be rendered obvious by any combination of the Blair patent and the Jackson Bulletin.

**Claims 33, 34, and 35**

The argument for claim 9 above, over the combination of the Blair patent and the Jackson Bulletin, is equally applicable for the argument of claim 33 over the combination of the Blair patent and the Jackson Bulletin. More specifically, neither the Blair patent nor the Jackson Bulletin discloses or suggests classifying input-output apparatuses into a plurality of categories having different functions and displaying the categories on a display as items to be selected. Therefore, as this feature is a requirement of claim 33 and not disclosed or suggested by the combination of the Blair patent and the Jackson Bulletin, claim 33 is distinguished and nonobvious over any combination of the Blair patent and the Jackson Bulletin.

Claim 34 and 35 depend from claim 33. Therefore, claims 34 and 35 are distinguished and nonobvious over any combination of the Blair patent and the Jackson Bulletin.

**Claim 37**

Claim 37, like claim 25, requires a step for classifying input-output apparatuses into a plurality of categories with different functions and for displaying the categories on a display as items to be selected. Neither the Blair patent nor the Jackson Bulletin discloses or suggests classifying input-output apparatuses into a plurality of categories with different functions. Therefore, claim 37 is distinguished and nonobvious over each of the Blair

patent and the Jackson Bulletin, and could not be rendered obvious by any combination of the two.

Accordingly, it is respectfully requested that the rejection of claims 9, 11, 12, 14, 16, 17, 25, 26, 33-35, and 37 under 35 U.S.C. § 103(a), as being unpatentable over the Blair patent in view of the Jackson Bulletin, be reconsidered and withdrawn.

**II. Claim 10, 13, 15, and 18**

The rejection of claims 10, 13, 15, and 18 under 35 U.S.C. § 103(a), as being unpatentable over the Blair patent in view of the Jackson Bulletin, as applied to claim 9 above, and further in view of the Sugiyama patent, is respectfully traversed based on the following.

Claims 10 and 13 depend from claim 9, and claims 15 and 18 depend from claim 14. As stated in the above arguments, the combination of the Blair patent and the Jackson Bulletin fail to disclose or suggest the feature of classifying input-output apparatuses into a plurality of categories with different functions and displaying the categories on a display as items to be selected, as required by claim 9; or classifying input-output apparatuses into a plurality of categories with different pieces of user identification information and for displaying on a display as items of selection the pieces of user identification information, as required by claim 14.

Although the Sugiyama patent does disclose a device capable of indicating an error such that a scanner/printer having an error can be identified apart from other scanner/printers, the Sugiyama patent, like the Blair patent and the Jackson Bulletin, does not disclose or suggest classifying input-output apparatuses into a plurality of categories with different functions and displaying the categories on a display as items to be selected, as required by claim 9; or classifying input-output apparatuses into a plurality of categories with different pieces of user identification information and for displaying on a display as items of selection the pieces of user identification information, as required by claim 14.

Therefore, claim 9 and dependent claims 10 and 13, as well as claim 14 and dependent claims 15 and 18 are distinguished over any combination of the Blair patent, the Jackson Bulletin, and the Sugiyama patent, and thus, could not be rendered obvious by any combination of these cited references.

Accordingly, it is respectfully requested that the rejection of claims 10, 13, 15, and 18 under 35 U.S.C. § 103(a), as being unpatentable over the Blair patent in view of the Jackson Bulletin, as applied to claim 9 above, and further in view of the Sugiyama patent, be reconsidered and withdrawn.

### III. Claim 57

The rejection of claim 57 under 35 U.S.C. § 103(a), as being unpatentable over the Blair patent, as applied to claim 56 above, and further in view of the Jackson Bulletin, is respectfully traversed based on the following.

Claim 57 depends from claim 56, and as shown, claim 56 is distinguished over the Blair patent. In particular, the Blair patent fails to disclose selecting a second printer automatically, from a plurality of printers connected to a network, as a substitute output apparatus in response to the determination that the first printer is not available, as required by claim 56.

In a similar manner, the Jackson Bulletin also fails to disclose this feature recited in claim 56. Thus, there is no combination of the Blair patent and the Jackson Bulletin that can render claim 56 and claim 57 obvious.

Accordingly, it is respectfully requested that the rejection of claim 57 under 35 U.S.C. § 103(a), as being unpatentable over the Blair patent, as applied to claim 56 above, and further in view of the Jackson Bulletin, be reconsidered and withdrawn.

**CONCLUSION**

Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

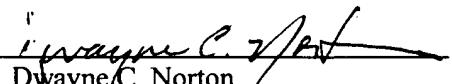
This Amendment does not increase the number of independent claims, does not increase the total number of claims, and does not present any multiple dependency claims. Accordingly, no fee based on the number or type of claims is currently due. However, if a fee, other than the issue fee, is due, please charge this fee to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

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